

Appl. No. 10/056,958
Amdt. Dated Sept. 25, 2003
Reply to Office Action of 07/25/2003

REMARKS

In this Final Office Action the Office has allowed claims 15-20; objected to claims 23, 24; and rejected claims 1-10 and 12-14, 21 and 22. The Applicant has canceled claim 23 and incorporated the elements within claim 1. Furthermore, Applicant has canceled claim 24 and incorporated those elements within claim 10. A terminal disclaimer is included herewith to overcome the double patenting rejection. Applicant respectfully requests reconsideration and allowance.

Priority Claim

Applicant requests that the Office acknowledge the claim of benefit under 35 USC § 119(e). The present application claims the benefit of U.S. Provisional Application No. 60/242,103 filed October, 20, 2000.

Drawings

Applicant requests that the Office to acknowledge the Drawing Office review of the drawings as noted in the Office Action Summary.

Allowable Subject Matter

The Office has indicated allowable subject matter pertaining to claims 15 – 20 and claims 23 and 24. Applicant thanks the Office for acknowledging the allowable subject matter.

Claims Rejections - 35 USC §112 First Paragraph

As quoted by the Office, the first paragraph of 35 U.S.C. 112 provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. [emphasis added].

This section of the statute requires that the specification include the following:

(A) A written description of the invention;

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(B) The manner and process of making and using the invention (the enablement requirement); and
(C) The best mode contemplated by the inventor of carrying out his invention.
MPEP§2161

The Office has rejected claim 22 for failing to comply with the written description for the 'controller electronics and processing circuitry' in the claim. Without prejudice, Applicant has amended claim 22 to include PI controller, heater, differential amplifier, and output amplifier. These elements are clearly recited in the specification. Review and allowance is respectfully requested.

Claims Rejections - 35 USC §102(b)

The Office rejected claims 1-5, 7,8 and 22 under 35 U.S.C. 102(b) as being anticipated by Clark (US 5,917,272). A rejection based on anticipation requires that a single reference teach every element of the claim (MPEP § 2131). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Or stated in another way, a "claim is anticipated only if each and every element as set forth in the claim is found, . . . described in a single prior art reference." *Verdegual Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . . .

Without prejudice, Applicant has amended claim 1 to incorporate the noted allowable subject matter of claim 23 with respect to the second substrate affixed to the floor of the package. Applicant respectfully requests reconsideration and allowance of claim 1, and as the further claims are dependent upon claim 1, claims 2-5, 7, 8, and 22 should be allowable.

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Claim Rejections – 35 USC § 103

The Office has quoted the statute from 35 USC 103(a), which is referenced therein. The Office has rejected claim 6, 9, 10, 12, 13, 14 and 21 as being unpatentable over Clark in view of IEEE Frequency Control Symposium, 1996. Applicant has carefully considered the Office rejections and respectfully submits that the amended claims, as supported by the arguments herein, are distinguishable from the cited reference.

According to the MPEP §2143.01, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art."

A useful presentation for the proper standard for determining obviousness under 35 USC §103(a) can be illustrated as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue;
3. Resolving the level of ordinary skill in the pertinent art; and
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

Without prejudice, Applicant has incorporate the allowable subject matter noted in claim 23 into claim 1, therefore those dependent claims 6, 9 and 21 should be allowable. Applicant has also amended claim 10 to include the limitations of allowed claim 23 for the second substrate secured to the package floor by posts. Applicant respectfully requests reconsideration of claim 10 and those claims dependent upon claim 10, 12, 13 and 14.

The Applicant states that the subject matter of the various claims was commonly owned at the time the invention was made.